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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/234,253	01/20/99	SELTZER	^{mik} A-21835/P2/C

000324 IM62/0111
CIBA SPECIALTY CHEMICALS CORPORATION
PATENT DEPARTMENT
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EXAMINER

ALVO, M

ART UNIT	PAPER NUMBER
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1731

9

DATE MAILED: 01/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/234,253

Applicant(s)
SELTZER et al

Examiner
Steve Alvo

Group Art Unit
1731



☒ Responsive to communication(s) filed on Oct 27, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-40 is/are pending in the application.

Of the above, claim(s) 12-34 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-11 and 35-40 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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The restriction and election of species requirements of Paper No. 7 are repeated and made Final. Applicant elected 1-43 and within the method: N,N-diethylhydroxylamine or its salt as the hydroxylamine and 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the stabilizer.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11 and 35-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over SELTZER et al in view of RODGERS et al.

SELTZER et al teaches adding mixtures of UV absorbers and light stabilizing agents, including N,N-diethylhydroxylamine (column 11, line 35 and column 12, line 66), to polymer coating compositions including polyurethane (column 8, line 12) and polyesters (column 8, line 30). RODGERS et al teaches using polyurethane and polyester coating compositions containing UV absorbers, including benzotriazoles (column 5, line 28 and Example 1), can be used to coat paper and textiles to prevent fading of dyes (column 1, lines 35-40 and abstract). It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes, e.g. reducing the loss of brightness, in the manner taught by RODGERS et al. SELTZER et al teaches that benzotriazoles are of particular value as the UV absorber. RODGERS et al teaches that 3-

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(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) can be used as the benzotriazol UV absorber (Example 21, see Table, column 13). It would have been prima facie obvious to use the 3-(2H-benzotriazol-2-yl)-4-hydroxy-5-sec-butylbenzene sulfonic acid or its sodium salt (CIBAFST®W) as the benzotriazol of SELTZER et al as they perform the same function of UV absorption.

Applicant's arguments with respect to basicity, e.g. the low basicity amines of SELTZER, have been considered but are not convincing as the claims are not limited to any acidity. As admitted by Applicant, SELTZER et al teaches using N,N-diethylhydroxylamine as a coadditive.

The argument that the fading of dyes and the loss of brightness are not equivalents is not convincing as it would have been obvious to combine the teachings of SELTZER with that of RODGERS to obtain the benefits of both preventing fading and increasing brightness. Besides, the claims drawn to a composition and not to the use of the composition. As set forth above, It would have been obvious to the routineer that the polyesters and polyurethanes of SELTZER et al which contain UV absorbers can be used to coat paper and textiles to prevent fading of dyes in the manner taught by RODGERS et al.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

When filing an **"Official" FAX** in Group 1730, please indicate in the Header (upper right) **"Official"** for papers that are to be entered into the file. The **"Official" FAX** phone numbers for this TC 1700 are:

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Any inquiry concerning this communication or earlier communications from the **primary examiner** should be directed to **Steve Alvo** whose telephone number is (703) 308-2048. The Examiner can normally be reached on Monday - Friday from 6:00 AM - 2:30 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Stanley Silverman, can be reached on 703-308-3837.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Group receptionist** whose telephone number is (703) 308-0661.

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Serial Number: 09/234,253

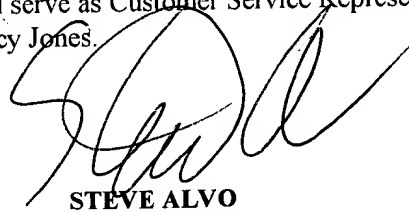
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MSA
January 10, 2001



STEVE ALVO
PRIMARY EXAMINER
ART UNIT 1731